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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,995	07/30/2001	James S-B Spragins	SPRG1	9763

26663 7590 08/12/2004

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BALTIMORE, MD 21202

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/917,995	SPRAGINS, JAMES S-B	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/30/2001</u>  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is responsive to communications: original application filed 07/30/2001; IDS filed 07/30/2001.
2. Claims 1-30 are currently pending in this application. Claims 1, 11, and 21 are independent claims.

***Claim Objections***

3. Claim 21 is objected to because of the following informalities: "said a video display" (lines 5-6) should read "said video display". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. As to independent claims 1, 11, and 21, the phrase "*may be*" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The resulting claim does not clearly set forth the metes and bounds of the patent protection desired. The use of similar exemplary language "for

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example” or “such as” was found to be indefinite in the following cases: Ex parte Hall, 83 USPQ 38 (Bd. App. 1949); Ex parte Hasche, 86 USPQ 481 (Bd. App. 1949); Ex parte Steigerwald, 131 USPQ 74 (Bd. APP. 1961).

Dependent claims 2-10, 12-20, and 22-30 are rejected for fully incorporating the deficiencies of their base claims

b. The following phrases lack antecedent basis:

- “said software” (claim 1, line 5; claim 11, line 5; and claim 21, line 5)
- “said writing” (claim 1, line 4; claim 11, line 5; and claim 21, line 5)
- “said markings” (claim 1, line 12; claim 11, line 13; and claim 21, line 13)
- “said set of markings” (claim 11, line 8; and claim 21, line 8)
- “said computer system” (claim 21, lines 12-13)

Dependent claims 2-10, 12-20, and 22-30 are rejected for fully incorporating the deficiencies of their base claims.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 10-16, 18, 20-26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hwang** (Patent Application Publication 2002/0042800A1 – filed

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06/2001, Foreign Application Priority Data filed 10/2000) in view of **Admitted Applicant Prior Art** (APA).

As to **independent claim 1**, Hwang teaches a method for providing feedback on an electronic writing created with a word processing software and wherein the writing being displayable using the software on a video display of a computer system (*page 5, para. 0105*), the method comprising the steps of:

- selecting from the set of editorial markings a marking to be inserted into the writing (*write or insert the selected web page contents into that note record file; page 2, para.0040 and 0077*);

- saving information pertaining to the inserted marking in the computer system so as to establish a database that documents the use of the markings in the writing (*save them in the note record file inside the server; page 2, para.0040*).

Hwang does not explicitly teach “developing a set of editorial markings that may be inserted into the writing and inserting the marking into the electronic writing.”

APA teaches developing a set of editorial markings that may be inserted into the writing and inserting the marking into the electronic writing (*page 1, lines 22-24 /page 2, lines 3-4*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from APA in the system of Hwang because it would have provided the capability for evaluating essay responses so that essay responses are evaluated and feedback is stored and released for retrieval by the students.

**As to dependent claim 2**, Hwang teaches compiling summary statistics for the saved markings that communicate information pertaining to the use of the markings in the writing (*page 2, para.0038*).

**As to dependent claim 3**, Hwang teaches filtering the inserted markings so that only a specified portion of such markings remain in the writing when it is returned to its writer (*page 2, para.0040*).

**As to dependent claims 4-6**, Hwang teaches hyperlinking the inserted marking to a website that exists on a network of linked computers (*page 4, para.0094*).

**As to dependent claim 8**, Hwang teaches the compiled summary statistics communicate information selected from the group consisting of information pertaining to: (a) specified skills that the writer would need to focus upon in order to improve the writer's writing skills, (b) for a series of the writings by the same writer, the writer's progress towards improvement in those areas identified by the inserted markings as needing improvement, (c) for a collection of writings by a group of writers who are being instructed as a group, the group's general areas denoted by the inserted markings as needing improvement, and (d) for a series of writings by the group, the group's progress towards improvement in those areas identified by the inserted markings as needing improvement (*page 2, para.0040/ page 3, para.0077*).

**As to dependent claim 10**, Hwang teaches the inserted marking having an associated editorial comment that is insertable in the writing (*page 2, para.0038 and 0040*).

**As to independent claim 11**, it is directed to a computer program product for implementing the method of claim 1, and is similarly rejected under the same rationale.

**As to dependent claims 12-16, 18 and 20**, they include the same limitations as in claims 2-6, 8 and 10, and are similarly rejected under the same rationale.

**As to independent claim 21**, it is directed to a computer program product for performing the method of claim 1, and is similarly rejected under the same rationale.

**As to dependent claims 22-26, 18 and 30**, they include the same limitations as in claims 2-6, 8 and 10, and are similarly rejected under the same rationale.

6. Claims 7, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hwang** in view of **Admitted Applicant Prior Art (APA)** and further in view of **Newbold et al.** (5,576,955 – issued 11/1996), as cited by Applicant's IDS.

**As to dependent claim 7**, the combination of Hwang and APA teaches the inserted marking communicates information, regarding a portion of the writing in proximity to the marking's insertion point (*page 2, section 0038 and 004 / page 3, section 0077*), but does not explicitly teach "chosen from the group consisting of information on the writing's punctuation, capitalization, italicization, grammar, word usage, content or form."

Newbold teaches chosen from the group consisting of information on the writing's punctuation, capitalization, italicization, grammar, word usage, content or form (*Abstract and col.2, lines 11-21*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Newbold's teachings in the system of Hwang as modified by APA because it would have provided the capability for scanning the errors to determine the manner in which to approach the correction of the errors.



**As to dependent claim 17**, it includes the same limitations as in claim 7, and is similarly rejected under the same rationale.

**As to dependent claim 27**, it includes the same limitations as in claim 7, and is similarly rejected under the same rationale.

7. Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hwang** in view of **Admitted Applicant Prior Art (APA)** and further in view of **Driscoll et al.** (5,987,302 – issued 11/1999), as cited by Applicant's IDS.

**As to dependent claim 9**, the combination of Hwang and APA does not explicitly teach “the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement.”

Driscoll the website having information chosen from the group consisting of detailed explanations of the markings and exercises that one can undertake in order to strengthen those writing skills which are denoted by the inserted markings as representing areas in which the writer needs improvement (*col.4, lines 47-65/ col.6, line 50 – col.7, line 1*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Driscoll's teachings in the system of Hwang as modified by APA because it would have provided the capability for providing useful instructional feedback to students about their skills relative to the assessment or test that the student wishes to take.

**As to dependent claim 19**, it includes the same limitations as in claim 9, and is similarly rejected under the same rationale.

**As to dependent claim 29**, it includes the same limitations as in claim 9, and is similarly rejected under the same rationale.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chiang et al.	U.S Patent No. 5,442,759	issued: Aug. 15, 1995
Anderson	U.S Patent No. 5,678,053	issued: Oct. 14, 1997
Rosen	U.S Patent No. 5,772,446	issued: Jun. 30, 1998

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
August 9, 2004



**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**